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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/265,788	03/10/99	LU	R 08291/482001

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EXAMINER

GARRETT, D

ART UNIT	PAPER NUMBER
1774	65

DATE MAILED: 07/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/265,788

Applicant(s)
Lu et al.

Examiner
Dawn Gerrett

Art Unit
1774



- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5-2-01
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-9, and 11-18 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-9, and 11-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Art Unit: 1774

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment, paper no. 14, dated May 2, 2001. New claims 16-18 were added (Applicant listed two claims numbered 16. The second occurrence of claim 16 has been renumbered claim 17). Currently, claims 1, 2, 4-9, and 11-18 are pending.
2. The text of those sections of Title 35, U.S. Code, not included in this action, can be found in the prior Office action, paper no. 13, mailed November 2, 2000.
3. Claims 1-2, 4-9, and 11-15 are again rejected and new claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richter (US 5,728,667) for the reasons set forth in paper no. 13, paragraph 7.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 17 recites a binary surfactant system which includes "(b) at least one further nonionic surfactant compound which is based on a polymeric alkylene oxide block copolymer" and later in the claim recites "0.1 - 8% of at least one further nonionic surfactant". It

Art Unit: 1774

is unclear if both occurrences of “at least one further nonionic surfactant” are the same or are different materials. Clarification and correction are required.

Response to Arguments

6. Applicant's arguments filed May 2, 2001 have been fully considered but they are not persuasive.

Applicant's new claims are rejected for the same reasons as the prior claims. New claims 16-18 use “consisting essentially of”. As stated in M.P.E.P. 2111.03:

The transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original). See also *Atlas Powder Co. v. E.I. duPont de Nemours & Co.*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *In re Janakirama - Rao*, 317 F.2d 951, 137 USPQ 893 (CCPA 1963); *Water Technologies Corp. v. Calco, Ltd.*, 850 F.2d 660, 7 USPQ2d 1097 (Fed. Cir. 1988). When an applicant contends that additional steps or materials in the prior art are excluded by the recitation of “consisting essentially of”, applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also *Ex parte Hoffman*, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989).

The examiner notes this language does not expressly exclude any other ingredients from being present in the composition and is considered open language

Applicant argues the Richter compositions are generally directed towards a “germicidal light-duty aqueous dishwashing detergent composition”. The examiner submits the present claims are directed to “aqueous disinfecting and cleaning compositions”. Furthermore, the

Art Unit: 1774

intended use of a composition is not patentably significant (see *In re Albertson*, 141 USPQ 730 (CCPA 1964); *In re Heck*, 114 USPQ 161 (CCPA 1957)), and different intended uses for two otherwise similar products is not a basis for a patentable distinction (see *In re Tuominen*, 213 USPQ 89 (CCPA 1982)). Additionally, "...in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim" (see M.P.E.P. § 2111.02, emphasis added). Applicant also argues "A glycoside surfactant is not described as being essential to the Richter compositions". In response, alkylpolyglycoside is taught as a preferred surfactant by Richter (see col. 10, lines 59-60).

Applicant requests reconsideration of the Declaration of Robert Zhong Lu under 37 CFR 1.132. Again, the examiner submits that the data is insufficient to establish unexpected results because components other than the alkylglycoside, GlucoPON, were varied. There is a lack of clear side-by-side comparisons between the inventive compositions and the comparison compositions to establish unexpected results.

Applicant argues "...Richter is silent as to the issue of mitigation". The examiner notes Richter recognizes the importance of a mitigating effect. In column 1, lines 44-50, Richter states "The use of further surfactants, i.e., the nonionic surfactants, in such formulations is generally to provide yet further detergic effect to the compositions, as well as other physical characteristics. For example, certain nonionic surfactant compositions are known to be generally milder

Art Unit: 1774

detergents for such cleaning applications.” The rejections over Richter are respectfully maintained.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Should you have any questions concerning this communication, please direct them to Dawn Garrett at 703-305-0788. The examiner can be reached at this number from about 9:00 am to 5:30 pm E.S.T. Monday-Friday. If attempts to reach the examiner by telephone prove unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached at 703-308-0449. Please allow the examiner twenty-four hours to return your call.

Art Unit: 1774

A facsimile center has been established for Group 1700 on the 8th floor of Crystal Plaza

3. The hours of operation are Monday through Friday, 8:45 am to 4:45 pm. The fax numbers for Art Unit 1700 are 703-305-3599 for official after-final faxes, and 703-305-5408 for all other official faxes. Use of the Group 1700 center will facilitate rapid delivery of materials to examiners in Art Unit 1774.

Any inquiry of a general nature, or those relating to the status of this application should be directed to the group receptionist whose telephone number is 703-308-2351.

DG
D.G.
July 18, 2001

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

